UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
[illegible]	[illegible]	[illegible]	[illegible]

LM52/0402

RAYMOND M MEHLER
COOK ALEX MCFARRON MANZO CUMMINGS & MEHL
SUITE 2850
200 W ADAMS
CHICAGO IL 60606

EXAMINER	
PRATT, H	
ART UNIT	PAPER NUMBER
1761	5

DATE MAILED: 04/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/583,334	Applicant(s) KEITHLY ET AL.	
	Examiner Helen F. Pratt	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-30 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)☐ All b)☐ Some * c)☐ None of the CERTIFIED copies of the priority documents have been:

1.☐ received.

2.☐ received in Application No. (Series Code / Serial Number) _____ .

3.☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) ☒ Notice of References Cited (PTO-892)
15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
17) ☐ Interview Summary (PTO-413) Paper No(s) _____
18) ☐ Notice of Informal Patent Application (PTO-152)
19) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-30 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-68 of copending Application No. 09/545,397. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the claims of the application include the limitations of the related application because they are both to extracting juice from orange cultivars from a particular season, and it would have been obvious to mix and blend to achieve a particular product.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending

application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-30 are rejected under the judicially created doctrine of double patenting over claims 1-47 of U. S. Patent No. 6,143,347 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claims of the patent encompass the application because they are to processes and products using the same oranges and claiming inherent characteristics of those oranges.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-20, 22-25, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonaventura et al. in view of "Citrus Industry", June 99, and Pao et al.

Bonaventura et al. disclose a product containing orange juice made by combining juices made from early, middle or late season fruit. Various sensory characteristics were evaluated depending on the fruit blend and sources used (abstract). Claim 1 differs from the reference in the use of particular cultivars or no particular cultivars and in using oranges from various peak properties time for the fruit with particular Brix acid ratios compared to other harvesting times.

. However, it is seen that it is known to blend juices from the various parts of the growing season. Certainly, it would have been within the skill of the ordinary worker to choose a particular cultivar which exhibits various characteristics such as sweetness and brix and acidity to blend with other juices. Citrus Growers disclose that the Hamlin orange is the standard for comparison for juice quality factors including color, yield and time of maturity (page 25, middle column). The reference also discloses that it would be helpful to have cultivars that mature ahead of the Hamlin orange with a 36 color score in Nov. or an orange that had good color in February and brix ratio.(page 24, 1st col.) . Pao disclose that the flavor quality of early season Hamlin oranges and grapefruit juices could be improved by blending with juices of many available variations (abstract). Therefore, it would have been obvious to make a product with particularly sensory characteristics.

Claims 2-4 further require that the harvesting occurs at particular seasons. However, the reference to Bonaventura et al. disclose that it is known to use fruits from early, middle and late seasons and to blend the juices together. Certainly, if one can harvest at particular time in one season, then one could harvest at other times of the year, knowing the particular characteristics of the juices. The further use of sensory scores from various cultivars is also seen as within the skill of the ordinary worker as in claim 6, and particular sources having green characters of a particular amount as in claim 7, bitterness as in claim 8 and sensory feeling as in claim 9, sourness as in claim 10, and other characteristics as in claim 11. The whole process of blending requires that various characteristics of the oranges is taken into consideration. The same is true for claims 12-20, 22 . Therefore, it would have been within the skill of the ordinary worker to

use various characteristics of the oranges produced at the same time for their known functions in blending of juices.

The particular amounts of juice are seen as within the skill of the ordinary worker as the reference because juice products with such are well known as in claim 5. Therefore, it would have been obvious to use various amounts of juices to make a particular composition.

The limitations of claims 23-25, 27 have been discussed above and are obvious for those reasons.

Claims 28-30 require particular characteristics of the juice and juices in particular amounts produced at various times. However, it is seen that as the characteristics of the juices are well known and can be determined by various tests, it would have been obvious to use juices with particular characteristics and in various amounts and to use particular cultivars for their known function of making particular juices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (703) 308-1978. The fax phone number for the organization where this application or proceeding is assigned is 703-873-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 3-29-01

H. Pratt

PRIMARY EXAMINER

1764